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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,632	12/30/2003	Thomas B. Mader	110578-135407	6893

25943 7590 08/16/2006

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EXAMINER
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DUPUIS, DEREK L

ART UNIT	PAPER NUMBER
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2883

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/748,632	MADER ET AL.	
	Examiner	Art Unit	
	Derek L. Dupuis	2883	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-15, 18 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16, 17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/30/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Amendment*

1. The declaration filed on 5/30/2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Scheibenreif reference.
2. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Scheibenreif reference. Specifically, the declaration does not establish a reduction to practice of the invention in this country or a NAFTA or WTO member country. Paragraph 1 of the declaration states that the inventor “was residing in the State of California, in or around the San Francisco Bay area” but the declaration does not positively establish that *reduction to practice* was in the US or a NAFTA or WTO member country.
3. The rejection under 103(a) as being unpatentable over the Scheibenreif reference has been repeated and a new ground of rejection have been made. This is a non-final action.
4. Applicant’s arguments, see pages 4 and 10, in combination with the amendments to the drawings and the specification filed 5/30/2006, with respect to the objection to the drawings and the objection to the specification have been fully considered and are persuasive. The objection to the drawings and the objection to the specification have been withdrawn.
5. Applicant’s arguments, see page 11, in combination with the declaration filed 5/30/2006, with respect to the rejection(s) of claim(s) 16, 17, and 19-21 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made and has been detailed below.

*Drawings*

6. The drawings were received on 5/30/2006. These drawings are accepted.

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16, 17, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Scheibenreif et al (US 2005/0036746 A1)*.

9. Scheibenreif et al teach an optical communication system including a client computing device and an optical communications adapter module (100) (see paragraph 3). The module is coupled to the client computing device for optical communications (see paragraph 3). An optical communications board assembly is positioned inside of the module (100) as seen in figure 1. Scheibenreif et al suggests that a single board can be used (see paragraph 21) for a more compact design. The board assembly is capable of coupling with the client computing device through an electrical connector (112). Optical connectors are extended to be positioned in the connector openings (128, 130) of the module. These connectors have been identified in the figures copied below as "second connector" and "fourth connector." A first optical connector is coupled to a second optical connector by a fiber optic cable (labeled "first cable"). This cable is shown in detail in figure 2). The first connector is coupled to a data transmission connector (116) of the board assembly. The second connect is positioned at the face plate of the module. A third optical connector is coupled to a fourth optical connector by a second fiber optic cable (labeled

Art Unit: 2883

below “second cable”). The third optical connector is coupled to a data reception connector (110) of the board assembly and the fourth connector is positioned at the face plate of the module. Scheibenreif et al also teach that the module can be XENPAK sized (see paragraph 23).

10. Scheibenreif et al do not explicitly state that the client computing device includes a microprocessor and a network processor coupled together or that the client computing device is one of a hub, a server, or a router. However, Scheibenreif et al teach that the client computing device is a computer (see paragraph 3). One of ordinary skill in the art would routinely use a microprocessor coupled to a network processor in a computer. Furthermore, one of ordinary skill in the art would also routinely use a compute as a hub, a router, or a server.

11. Claims 16, 17, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Yamaji et al (US 5,708,745)* in view of *Montalvo et al (US 2003/0147385 A1)*.

12. Yamaji et al teach an optical communications system including an optical communications adapter module (1) with an external output. The module includes an optical communications board assembly (13) being positioned with the module (1) so the board assembly (13) is capable of coupling with an external device through an electrical connector (3) (see column 4, line 57 to column 5, line 28). Optical connectors of the assembly are extended via optical extension cables to be positioned in connector openings (2a, 2b) of the module as shown in figure 4. The module includes a first optical connector coupled to a second optical connector (9) by fiber optics (11). The first optical connector is coupled to a data transmission connector (left port of E/O device 12) of the optical communications board assembly as shown in figure 4. The second optical connector (9) is positioned at a face plate of the module as seen in figure 4. A third optical connector is coupled to a fourth optical connector (8) through fiber

Art Unit: 2883

optics (10) capable of transmitting data. The third optical connector is coupled to a data reception connector (right port of the E/O device 12) of the optical communications board assembly as shown in figure 4. The fourth optical connector (8) is positioned at the face plate of the module as shown in figure 4.

13. While Yamaji et al teach that the module is coupled with an external device, Yamaji et al do not explicitly state that the external device is a client computing device such as a hub, server, or router. Montalvo et al teach an optical communications network routing system. Montalvo et al teach that the ports of the system can include industry-standard modules such as XENPAK sized modules (see paragraph 24). Montalvo et al do not explicitly state that the client computing device includes a microprocessor and a network processor coupled together. However, Montalvo et al teach that the client computing device is a communications network routing system. One of ordinary skill in the art would routinely use a microprocessor coupled to a network processor in such a system.

14. It would have been obvious to one of ordinary skill in the art to use the module taught by Yamaji et al in the communications system as taught by Montalvo et al. Motivation to do this would be that “one of ordinary skill in the art will recognize, because of the variety of physical and optical fiber optic connection types, that the physical port [of the system] may be partially or completely contained in an industry standard fiber optic module” (see paragraph 24 of Montalvo et al). Furthermore, Yamaji et al suggest using the module for connection to an external subscriber device in a network (see column 4, line 57 to column 5, line 28 of Yamaji et al).

#### ***Double Patenting***

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

Art Unit: 2883

improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 16, 20, and 21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14-20 of copending Application No. 10/748982. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to combine the limitations of the dependent claims since the specification discloses that some of the limitations belong to the same embodiment.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 16, 20, and 21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14-20 of U.S. Patent No. 7,008,122. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to combine the limitations of the

dependent claims since the specification discloses that some of the limitations belong to the same embodiment.

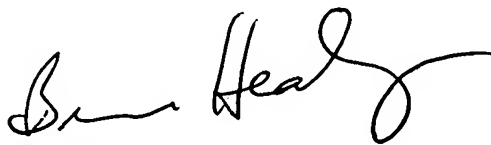
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derek L. Dupuis whose telephone number is (571) 272-3101. The examiner can normally be reached on Monday - Friday 8:30am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font can be reached on (571) 272-2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Derek L. Dupuis  
Group Art Unit 2883

  
**BRIAN HEALY**  
**PRIMARY EXAMINER**